

REMARKS

Interview Summary

Applicant thanks the Examiner for the telephonic interview of March 9, 2006. During the interview, Applicant's attorney and Examiner discussed the differences between Applicant's claims and the cited references, which contain no mention of oak dust. Examiner agreed to reconsider the rejection in view of Applicant's position that "oak dust" as defined in the specification is the oak dust associated with the wine-making industry, which necessarily excludes dust made from natural cork. Examiner agreed that the §102 and §103 rejections would likely be withdrawn if Applicant could show by affidavit that a person of ordinary skill in the wine-making industry would consider the definition of "oak dust" to exclude natural cork. Examiner also asked that Applicant submit arguments regarding Strauss and Snogren and Applicant's position that these references are non-analogous art.

Amendments to the Claims

Claims 1-27 are pending in the application. Claims 1, 6-8, 10, and 15-17 are currently amended. Claims 19-27 have been withdrawn.

Objections to Specification and Claims

The specification and claims have been amended to correct the spelling of "ethynyl cyclohexanol." Applicant respectfully requests that the objection be withdrawn.

Claim Rejections – 35 USC §102

Claims 1, 2, 4, 5, 10, 11, 13, and 14 were rejected under 35 U.S.C. 102(e) as being anticipated by Oka et al (WO 03/020817). The Office Action stated:

The reference to Oka et al (WO 03/020817) teaches the combination of methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as

contemplated and herein claimed. Paragraphs [008] through [0010] show the resin (including claims 2 and 11). The fumed silica is included at paragraph [0011]. The use of cross-linking agents include an organic peroxide (claims 5 and 14) at paragraph [0013] and chloroplatanic acid (claims 4 and 13) at paragraph [0017]. Those citations teach the amounts claimed for each compositional limitation, as embraced by the reference.

As amended, Claims 1 and 10 include the limitations of former Claims 6 and 15, respectively. The Oka reference therefore fails to disclose each and every element of Claims 1, 2, 4, 5, 10, 11, 13, and 14. Applicant respectfully requests that the rejections of Claims 1, 2, 4, 5, 10, 11, 13, and 14 under 35 U.S.C. § 102 as being anticipated by Oka be withdrawn.

Claims 1, 2, and 4 were rejected under 35 U.S.C. 102(b) as being anticipated by Merguriya I (U.S. Patent No. 5,981,610). The Office Action stated:

The patent to Merguriya et al. (US 5,981,610) teaches the inclusion of the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. Note column 2 (lines 19 et seq.) for the resin. Note the paragraph bridging column 3 to column 4 for the use of fumed silica as a known thixotropic agent. Note column 4 (lines 17-22) for the use of chloroplatanic acid, as recited in claim 4. The use of a hollow filler is shown at column 4 (lines 27-48). Further, note the Examples for particular embodiments that embrace the compositional limitations as herein claimed.

As amended, Claim 1 includes the limitations of former Claim 6. The Merguriya I reference therefore fails to disclose each and every element of Claims 1, 2, and 4. Applicant respectfully requests that the rejections of Claims 1, 2, and 4 under 35 U.S.C. § 102 as being anticipated by Merguriya I be withdrawn.

Claims 1, 2, 4, and 5 were rejected under 35 U.S.C. 102(b) as being anticipated by Merguriya II (U.S. Patent No. 6,506,331). The Office Action stated:

The patent to Merguriya (US 6,506,331) teaches the inclusion of the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent

and a cross-linking agent, in the compositional limitations as contemplated as herein claimed. Note column 2 (line 51) to column 3 (line 34) for the resin. Note column 5 (lines 1-16) for the use of fumed silica as a filler. Note column 4 (lines 34-52) for the use of chloroplatanic acid, as recited in claim 4, and (lines 53-64) for the peroxide component. The use of a hollow filler is shown at column 5 (lines 17-64). Further, note the Examples of particular embodiments that embrace the compositional limitations as herein claimed.

As amended, Claim 1 includes the limitations of former Claim 6. The Merguriya II reference therefore fails to disclose each and every element of Claims 1, 2, 4, and 5. Applicant respectfully requests that the rejections of Claims 1, 2, 4, and 5 under 35 U.S.C. § 102 as being anticipated by Merguriya II be withdrawn.

Claim Rejections – 35 USC §103

Claims 1-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Oka et al (WO 03/020817), Merguriya I (U.S. Patent No. 5,981,610), or Meguriya II (U.S. Patent No. 6,506,331), each as applied to the rejected claims under §102, and further in view of Descamps et al (U.S. Patent No. 5,162,397), Strauss (U.S. Patent No. 4,031,059), and Snogren (U.S. Patent No. 3,296,153) all taken together. The Office Action stated:

The references to Oka et al (WO 03/020817), Merguriya et al. (US 5,981,610) and Merguriya (US 6,506,331) each show the broad composition of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed.

The reference to Oka et al. (WO 03/020817) also teaches the use of pigments at paragraph [0027] and 1-ethynyl-cyclohexanol, used as a curing inhibitor, at paragraph [0028] as recited in instant claims 8, 9, 17 and 18.

The reference to Merguriya et al. (US 5,981,610) teaches the employment of “ethynyl cyclohexanol as a reaction regulator,” at Example 5, bridging column 8 to column 9. At column 5 (lines 1-16) the reference teaches the use of carbon black, zinc white,

known colorants. Both features as recited in instant claims 8, 9, 17 and 18.

The reference to Merguriya (US 6,506,331) teaches the employment of “ethynyl cyclohexanol as a reaction regulator,” at Example 1, column 7, and the use of carbon black and zinc white at column 5 (lines 1-16).

The reference to Descamps et al. (US 5,162,397) teaches the manufacture of a composition including a polysiloxane resin, including polydimethylvinylsiloxane at column 2 (lines 30 et seq.), a cross-linking agent of chloroplatanic acid at column 10 (lines 9 and 10) with a silica filler at column 7 (lines 9-16) and a microsphere agent, including the borosilicates of claims 3, 7-9, 12 and 16-18. Note column 1 (lines 50-66) and column 10 (lines 15-24 and 43-63) for the borosilicates and their compositional inhibitor, such as an acetylenic alcohol (ethynyl cyclohexanol is one) at column 4 (lines 1-25). Carbon black may be included at column 7 (lines 8-16).

The reference to Strauss (US 4,032,059) teaches the manufacture of a composition including a polysiloxane resin, including polydimethylvinylsiloxane at column 13 (line 31) to column 14 (line 12), with hollow microspheres at column 14 (lines 36 et seq.), a curing agent and a silica filler. Note the Examples. The reference teaches the inclusion of ground cork at the paragraph bridging column 4 to column 5 and column 6 (lines 18-26). The reference is clear as to why ground cork, microspheres and other low density fillers are employed, and deemed essentially equivalent, at column 2 (lines 11-20) and column 4 (lines 59 et seq.) as having a “lower thermal conductivity and higher specific heat.

The reference to Snogren (US 3,296,153) teaches the manufacture of a resin filled composition that may comprise a polysiloxane with a curing agent. The reference further teaches at column 7 (lines 23-66) and Table III, the use of “granulated cork, charred granulated cork” and “small hollow micro spheres,” which may be glass or ceramic materials and may comprise the borosilicates of the instant claims and silica as suitable filler materials. Note the many Examples.

The primary references to Oka et al (WO 03/020817), Merguriya et al (US 5,981,610) and Merguriya (US 6,506,331) all show the broad composition as conventional to include a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the

compositional limitations as contemplated and herein claimed. The secondary references are relied upon to show the conventionality of each of the various constituents recited in claims 3, 6-9, 12 and 16-18, including the borosilicate microspheres, the toasted oak dust ("charred granulated cork"), pigment, silicon hydride and ethynyl cyclohexanol in silicone resins, including those recited and claimed herein. Since these references represent art analogous in scope, one having an ordinary skill in the art would have a high level of expectation of success. The manipulation of the compositional limitations, depending on availability of materials, anticipated physical characteristics and cost procedures for the manufacture would clearly be within the purview of an artisan skilled in the art. The primary references teach such levels of inclusion. As such, the instant claim would have been obvious to a practitioner in the art in view of the references cited, absent any showing of unexpected results.

Claims 1-18 are not rendered unpatentable under 103(a) in view of the cited references because the Office Action fails to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP §2142. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

References Do Not Teach or Suggest All of the Claim Limitations

Applicant respectfully submits that the cited references fail to teach or suggest each and every element of the rejected claims. With respect to Claims 1-9, the references, taken together, do not teach or suggest a synthetic cork compound having *oak dust from about 0.1 to 25 weight percent*. With respect to Claims 10-18, the references, taken together, do not teach or suggest a

synthetic cork compound having *oak dust of about 1.0 weight percent*. As stated in Applicant's originally-filed specification, the inclusion of oak dust (toasted or untoasted), gives the resulting synthetic cork compound a mottled, speckled, or non-uniform appearance that closely resembles natural cork (see paragraph [0025]). This is important since one of the many possible uses of Applicant's compound is to provide a synthetic alternative to natural cork stoppers in wine bottles. The wine industry has in many cases been slow to adopt synthetic stoppers, and one commonly-stated reason for this is that synthetic stoppers do not closely resemble natural cork stoppers. Hence, the inclusion of oak dust as an ingredient greatly increases the likelihood of acceptance of Applicant's product as a synthetic substitute for natural cork wine stoppers. The effects of oak dust on Applicant's claimed invention are supported by the enclosed Affidavit of Jeannie Holmes.

Both Snogren and Strauss are cited in the Office Action for the teaching of ground cork, granulated cork, or microspheres in a silicone resin. The Office Action states that the inclusion of ground cork teaches or suggests the oak dust component of Applicant's claimed invention. However, Applicant submits that oak dust is not taught or suggested by the inclusion of ground or granulated cork in a silicone resin. "Oak dust" has a specific meaning as contemplated by Applicant's claimed invention and is defined in Applicant's originally-filed specification as the ingredient that is sometimes used by wine-makers to enhance the flavor of wine (see paragraph [0025]). Oak dust is not taught or suggested by the use of granulated or ground natural cork since the oak dust used by wine-makers is manufactured from specific types of oaks and is not ever manufactured from natural cork.

While Applicant recognizes that wine making is not the field of Applicant's invention, Applicant has specifically defined oak dust in the specification as being the ingredient used by

wine-makers when making wine. For this reason, it is proper to consider the statements of a person skilled in the art of wine making. Accordingly, Applicant submits herewith an Affidavit of Lawrence D. Tiberia, a winemaker and owner of Barking Rocks Winery. As stated by Mr. Tiberia, the trees from which oak dust is obtained for use in wine-making are grown in the United States, France, and several Eastern European countries. Oak dust used as a wine-making additive is primarily manufactured from white oak tress, but not from natural cork or cork oak trees. In addition to there being no benefit to the addition of natural cork to wine, the addition of natural cork could have detrimental effects on the wine since natural cork could introduce trichloroanisol (TCA) to the wine. As described in Applicant's specification at paragraph [0009], TCA is the primary cause of tainted wine and causes wine to develop a musty taste and smell.

Based on Applicant's definition of oak dust and the support of an expert in the field of wine making, it should be clear that Applicant's claimed inclusion of oak dust necessarily excludes the use of granulated or ground cork. Consequently, the Strauss and Snogren references, taken in combination with the other cited references, do not teach or suggest each and every element of the rejected claims.

No motivation to combine

The rejection of the Claims 1-18 over Oka, Merguriya I, or Meguriya II in view of Descamps, Strauss, and Snogren is improper because there is no motivation to combine either Strauss or Snogren with the teachings of Oka, Merguriya I, or Merguriya II. Oka teaches a silicone compound for gaskets and rollers for copiers, printers, and facsimile machines. Both Merguriya I and Meguriya II teach silicone rubber polymers having relatively low specific gravities. Both Straus and Snogren are cited in the Office Action for their teachings of ground or

granulated cork, which, according to the Office Action, is suggestive of oak dust.

Notwithstanding Applicant's previous arguments that Strauss and Snogren fail to teach or suggest oak dust, a person of ordinary skill in the art of Applicant's invention would not have looked to either Strauss or Snogren in combination with the other cited references to create the claimed invention. Both Strauss and Snogren teach low-density ablative materials for protecting re-entry vehicles during high-speed atmospheric travel. Both Strauss and Snogren cite the use of cork for lowering the density of the resulting composition (in Strauss, see FIG. 3; in Snogren, see column 7, lines 30-37). Strauss further cites the use of cork as providing "lower thermal conductivity and higher specific heat" (see column 2, lines 11-20). Neither Strauss nor Snogren teach or suggest that the benefit of adding ground or granulated cork to a silicone composition results in the benefit of adding oak dust to the composition of Applicant's claimed invention. Applicant's originally-filed specification states that oak dust "gives the resulting product a mottled, speckled, or non-uniform appearance that closely resembles natural cork." Since Strauss and Snogren do not suggest the inclusion of ground or granulated cork for these reasons, there is no motivation to combine Strauss and Snogren with Oka, Merguriya I, or Meguriya II.

Use of nonanalogous art

Applicant further submits that the rejection of Claims 1-18 under §103(a) is improper because the Office Action relies upon nonanalogous art to make the rejection. According to MPEP §2141.01(a), the Examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed.

Cir. 1992). *See also In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

The Strauss and Snogren references are not analogous art to the subject matter of Applicant's claimed invention. Both Strauss and Snogren teach low-density ablative materials for protecting re-entry vehicles during high-speed atmospheric travel. The synthetic cork compound of Applicant's invention is aimed at providing a substitute for natural cork. The cork compound eliminates many of the unfavorable characteristics of natural cork, while maintaining many of the favorable characteristics. The low-density ablative materials taught by Strauss and Snogren, on the other hand, are directed to protecting space vehicles during high temperature re-entries into the Earth's atmosphere. Strauss and Snogren are neither in the field of Applicant's endeavor, nor are they reasonably pertinent to the particular problem with which the Applicant was concerned (i.e. providing a substitute for natural cork). Because there is no connection or link between the Applicant's invention and the teachings of Strauss and Snogren, the Strauss and Snogren references are nonanalogous art and should not be used to reject Applicant's claimed invention under §103(a).

Because the cited references fail to teach or suggest all of the limitations of Applicant's claims, because there is no motivation to combine the teachings of Strauss and Snogren with the other references, and because Strauss and Snogren are nonanalogous art, the cited combination of references does not established a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the rejections of Claims 1-18 under 35 U.S.C. §103(a) be withdrawn.

Double Patenting Rejection

As amended, and for the reasons stated above, Claims 1-18 overcome the nonstatutory obviousness-type double patenting rejection over Claims 1-16 and 21-41 of copending Application No. 10/685,052 in view of Snogren and Oka.

Applicant respectfully requests that the double patenting rejection be withdrawn.

CONCLUSION



Applicant respectfully submits that the pending Claims 1-18 are in condition for allowance and such a Notice is respectfully requested. The Examiner is invited to call the undersigned at the below-listed telephone number if, in the opinion of the Examiner, such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

DATE: 4/3/06

A handwritten signature in cursive script, appearing to read "RC Hilton", written over a horizontal line.

Robert C. Hilton
Reg. No. 47,649
PATTON BOGGS LLP
2001 Ross Avenue
Suite 3000
Dallas, Texas 75201
TEL: 214- 758-6641
FAX: 214-758-1550

ATTORNEYS FOR APPLICANT